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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,843	12/21/2004	Lutz Schneidereit	AT 020044	1284
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			EXAMINER CHOW, VAN NGUYEN	
			ART UNIT 2627	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/518,843

Applicant(s)

SCHNEIDERREIT ET AL.

Examiner

VAN N. CHOW

Art Unit

2627

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/24/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-23 is/are allowed.
- 6) ☒ Claim(s) 1-11 and 15-17 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

1. This office action is in response to the Remand by the Board mailed 3/24/09.
2. Claims 8-11 are interpreted as **invoking 112, 6th paragraph**, in reciting means for determining, gating means for generating, first generating means for generating, and second generating means for generating. The recitation of the first generating means as being performed by means of an XOR gating operation and the gating means as being performed by means of an XOR function is not considered a recitation of sufficient structure to achieve the function, in view of the disclosure which defines the XOR gating operation and XOR function in terms of software (see specification, page 3, line 18 – page 4, line 2). Claims 9-11 are interpreted as **not invoking 112, 6th paragraph**, in reciting third generating means to generate and fourth generating means to generate, since the required format was not used, i.e., “means for”.

Claims 1-7 and 15-16 are interpreted as **not invoking 112, 6th paragraph**, in defining the method by reciting “is formed”, “for generating”, and “to generate”, since the required format was not used, i.e., “step for”. Further, even if the proper format were used, the claimed XOR gating operation and XOR function corresponding to such steps would be considered sufficient acts to achieve the method steps. Hence, such steps would be interpreted as **not invoking 112, 6th paragraph**.

3. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

Applicant is required to provide clarification of the correlation and identification of what structure, material, or acts set forth in the specification would be capable of carrying out each of the means plus functions of claims 8-11, i.e., means for determining, gating means for

generating, first generating means for generating, and second generating means for generating.
See MPEP 704.11(a)(R).

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 8-11 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 8-11 and 17 are drawn to a “computer program” *per se*, therefore, fail(s) to fall within a statutory category of invention.

A claim directed to a computer program itself is non-statutory because it is not:

A process occurring as a result of executing the program, or

A machine programmed to operate in accordance with the program, or

A manufacture structurally and functionally interconnected with the program in a manner which enable the program to act as a computer component and realize its functionality,
or

A composition of matter.

Claim 8 recites means for determining, gating means for generating, first generating means for generating, and second generating means for generating, claims 9-10 recite third generating means to generate, and claim 11 recites fourth generating means to generate, which as disclosed are software, per se (see specification, page 3, line 18 – page 4, line 2).

Claim 17 recites “computer software product”.

6. Claims 1-7 and 15-16 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention.

Supreme Court precedent and recent Federal Circuit decisions indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, the claimed steps of forming and generating data blocks using XOR gating operation are mere manipulation of data values that could be accomplished mentally using merely a pen and piece of paper. The claimed steps are disclosed as being accomplished by general purpose computer using software (see specification, page 3, line 18 – page 4, line 2). This is not considered to meet the “tied to another statutory category” requirement (see *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008)(en banc), at 955, *Gottshalk v. Benson*, 409 U.S. 63, 71-72 (1972)). Claims 15-16 recite a means for receiving and changer module, which are apparatus. However, there is no method step tied to this apparatus.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 8-11 and 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8-11 are interpreted as invoking 112, 6th paragraph, in reciting means for determining, gating means for generating, first generating means for generating, and second generating means for generating, which means do not comply with the requirements of 35 U.S.C. § 112, second paragraph as set forth in MPEP § 2181(III). As discussed in this section of the Manual, when 35 U.S.C. § 112, six paragraph has been invoked, the requirements of 35 U.S.C. § 112, second paragraph are complied with if the corresponding structure, material, or acts are described in the Specification in specific terms and an ordinarily skilled artisan could identify the structure, material, or acts from the description.

In re claim 8, "determining means for determining the item of start position information", there is not sufficient description of corresponding structure to perform the function of determining the item of start position information in the specification in specific terms and an ordinarily skilled artisan cannot identify the structure from the description. The specification describes a changer module 40 as the mechanism used in determining items of start position; however, the "determining means" does not include the mechanism, rather it is what controls the mechanism. The "determining means" are provided in a computer software product that comprises software code (see the specification, page 6, lines 23-24 and page 3, line 18 – page 4, line 2). In re claim 8, "gating means for generating", "first generating means for generating", and "second generating means for generating", there is not sufficient description of

corresponding structure to perform the function of determining the item of start position information in the specification in specific terms and an ordinarily skilled artisan cannot identify the structure from the description. The “gating means for generating”, “first generating means for generating”, and “second generating means for generating”, are provided in a computer software product that comprises software code (see the specification, page 3, line 18 – page 4, line 2). Applicant should note *Aristocrat Tech. Australia Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328 (Fed. Cir. 2008) and *Finisar Corp. v. The DirectTV Group*, 523 F.3d 1323 (Fed. Cir. 2008). Both of these cases relate to computer-implemented means-plus-function claim limitations that invoke 35 U.S.C. § 112, sixth paragraph. In *Aristocrat*, the court stated that the corresponding structure in the specification must be more than a general purpose computer or microprocessor with appropriate programming to satisfy the definiteness requirements of 35 U.S.C. § 112, second paragraph. This is because a general purpose computer or microprocessor can be programmed to perform very different tasks and does not limit the scope of the claim to any particular structure that performs the function. In *Finisar*, the court explained that reciting software without providing some detail about the means to accomplish the function does not adequately disclose the corresponding structure that define the bounds of the invention. In this case, none of the means has structure disclosed that can be identified in specific terms.

Claims 15-16 are indefinite as there is no antecedent basis for “the reproducing arrangement”.

9. Claim 18 is statutory in reciting a computer-readable medium, which is an article of manufacture. Claims 19-23 are statutory in reciting a device to provide data that is stored on a medium, which is an apparatus.

10. Claims 1-11 and 15-17 are allowable over the prior art of record for the reasons of record.

The § 112 and § 101 rejections need to be overcome.

11. Claims 19-23 are allowable over the prior art of record for the reasons of record.

Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN N. CHOW whose telephone number is (571)272-7590. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne R. Young can be reached on 571-272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Van N. Chow/
Examiner, Art Unit 2627

/Wayne Young/
Supervisory Patent Examiner, Art Unit 2627